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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,397	06/29/2001	Yasuo Narita	18920.0019	6006

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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

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DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,397

Applicant(s)

NARITA ET AL.

Examiner

Mark A Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 1,11-13 and 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Aser et al. Aser et al. teaches making a roller by providing a steel core, placing a silicone rubber tube over the core, and heat shrinking the tube to bond the tube to the core (column 3, lines 6-14). The roller of Aser is thinner toward the ends than between the ends (See Figs. 2 and 3 wherein sleeve, 12, is only located between the ends of the roller.) The rejection considers the roller of Aser et al. to have a “small diameter” because the limitation intended by “small” is not distinctly defined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aser et al. in view Nose et al. Nose et al. teaches that resin rollers of a small

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diameter are typically used in hand held film transfer tools. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the roller of Aser et al. in a hand held film transfer tool because Nose et al. shows the use of a resin roller for this purpose. The rejection is based on a strict reading of the preamble to be interpreted in light of the specification to be directed to rollers in *hand held* film transfer tools.

5. Claims 2 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aser et al. in view of WO99/30913 (Reil et al.). Reil et al. teaches that plastic covered rollers conventionally employ disks on the shaft to prevent the plastic tube to slide off the shaft (column 1, lines 9-15 of English language equivalent U.S. 6,444,065). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add disks on the shaft of the invention of Aser et al. because Reil et al. teaches the known advantages in preventing slippage of the covering of a roll.

Response to Arguments

6. Applicant's arguments filed January 23, 2003 have been fully considered but they are not persuasive. Applicants argue that the cited references do not show a roller which has a smaller diameter on the ends than between the ends. This is not persuasive as the primary reference to Aser shows in Figs. 2 and 3 that sleeve, 12, is only located between the ends of the roller, thereby making the diameter of the roller larger in the middle than at the ends before application of heat shrinkable sleeve, 17.

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Election/Restrictions

7. This application contains claims 1, 11-13, 17-23 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Japanese Patent Publication 1-264236 shows a roller with a larger diameter in the center than at the ends. Previously cited references to Chapman and Reil et al. also show rollers with narrow shafts at the ends for placement of the roller into an apparatus.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 703-308-2063. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



MARK A. OSELE
PRIMARY EXAMINER

April 7, 2003